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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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07/21/2005

Sadanobu Shirai

2005-1129A

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WENDEROTH, LIND & PONACK, L.L.P.

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SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

08/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/542,932	Applicant(s) SHIRAI, SADANOBU	
	Examiner MELISSA S. MERCIER	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,10,12,17,18,20 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2,4-6,8-9,11,13-16,19, 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 4, 2008 has been entered.

Claims 1-24 are pending in this application. Claims 3, 7, 10, 12, 17-18, 20, and 24 remain withdrawn from consideration. Claims 1-2, 4-6, 8-9, 11, 13-16, 19, 21-23 remain under prosecution in this application.

Claim Rejections - 35 USC § 112

In view of Applicants Amendments to claims 4 and 9, the rejection under 35 USC 112, first paragraph has been withdrawn. However, after further consideration, the following rejections under 35 USC 112 have been applied.

Claims 1-2, 4-6, 8-9, 11, 13-16, 19, 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what applicant is actually claiming. The limitation "a thin aqueous cataplasm material" does not appear to be commensurate with the description in the specification. A definition search of cataplasm results in the following definition:

Cataplasm (noun): a medical dressing consisting of a soft heated mass of meal or clay that is spread on a cloth and applied to the skin to treat inflamed areas or improve circulation etc.

obtained from "thefreedictionary.com". Applicant is requested to clarify the claimed invention. For purposes of prosecution, the claims have been interpreted to be a medical dressing, comprising a support layer with an adhesive backing and a fiber film.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 4-6, 8-9, 11, 13-16, 19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney et al. (US Patent 5,814,031) in view of Misumi et al. (US Patent 6,224,899).

Mooney discloses a structured occlusive dressing. The dressing can be applied directly to a wound, or may be coated directly onto a film or fiber substrate which is, in turn applied to the wound and surrounding skin (column 2, lines 16-36).

The films may be composed of one or more polymers including polyethylene (column 6, lines 22-29), which is a soft plastic resin and the specific resin of claims 6, and 14-16.

The dressings may also be coated onto a fiber substrate which, in turn, is adhesively or otherwise attached to a film substrate. As discussed below, the claims are

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drawn to a product prepared by a particular process; patentability is based on the final product. Applicant is invited to present evidence as to the criticality of the heat fusing means of attachment if it results in a different product being formed.

Mooney discloses fiber substrates including fabrics that are knitted such as modified entangled fiber composed of rayon polyesters, such as 90:10 polypropylene-rayon blends (column 6, lines 30-41), which is the particular combination disclosed in instant claims 6 and 14-16.

Mooney additionally discloses generic teachings of adhesive surfaces applied to the film (Example 1).

Mooney does not disclose the particular adhesive composition of instant claims 4, 8-9, 19, and 21-23.

Misumi discloses an adhesive composition comprises a polyacrylic acid compound, a polyvalent metal component and water, wherein the content of water is 75 to 95% by weight (abstract).

The amount of polyacrylic acid present is 1-20% by weight (column 3, lines 50-51).

Suitable examples of the polyvalent metal component are aluminum, including aluminum hydroxide (column 3, line 53- column 6, line 2). The amount of polyvalent metal compound is 0.01-20% by weight (column 4, lines 16-17).

The adhesive cooling composition may further contain a polyhydric alcohol, such as glycerin, propylene glycol, and butylenes glycol (column 5, lines 9-25). The amount of polyhydric alcohol can be 0.001-30% by weight (column 5, lines 26-27).

Additionally, an acid may be added to the adhesive composition to adjust the pH of the composition (column 4, line 66-column 5, line 1).

Regarding claims 5, 11, and 13, the thickness of the composition to be laminated to a film is in the range of 50-200g per square meter (column 9, lines 42-45).

The instant claims differ from the references only in the specific weight of the water present in the adhesive layer. However, it would have been deemed *prima Facie* obvious to one having ordinary skill in the art at the time of the invention to optimize the amount of the adhesive layer utilized in order to provide a cataplasm with the desired properties in order to provide the desired adhesive effect. Therefore, it is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been *prima face* obvious to one of ordinary skill in the art at the time the invention was made.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the adhesive composition of Misumi with the dressing of Mooney since each of the references teach that patches would comprise adhesive layers, for application of compositions to the skin, it would have been obvious to combine these adhesives with the expectation that such a combination would have the desired effectiveness, such as an adhesive composition which stably contains a large amount of water and which is excellent in cooling effect and/or coolness-preserving effect (Misumi, column 1, lines 48-52).

Applicants attention is drawn to MPEP 2113, regarding Product by Process claims; which recites: “[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615